



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,149	04/23/2001	Ranjit Sahota	007412.01057	6058
71867 7590 11/08/2010 BANNER & WITCOFF, LTD ATTORNEYS FOR CLIENT NUMBER 007412 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051				
EXAMINER				
VAN HANDEL, MICHAEL P				
ART UNIT		PAPER NUMBER		
2424				
MAIL DATE		DELIVERY MODE		
11/08/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/841,149

**Applicant(s)**

SAHOTA, RANJIT

**Examiner**

MICHAEL VAN HANDEL

**Art Unit**

2424

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 8-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

## **DETAILED ACTION**

### ***Miscellaneous***

1. The examiner notes the new grounds of claims **24-27** under 35 USC 101. As this grounds of rejection was not presented in the previous Office Action, the rejections in this Office Action are hereby made Non-Final.

### ***Response to Amendment***

2. This action is responsive to an Amendment filed 8/11/2010. Claims **1-6, 8-27** are pending. Claims **1, 4, 8, 14-17, 19-21, 23, 24, 26, 27** are amended. Claim **7** is canceled.

### ***Response to Arguments***

3. Applicant's arguments regarding claims **1, 8, 15, 20, 24, and 27**, filed 8/11/2010, have been considered, but are moot in view of the new ground(s) of rejection.

### ***Claim Objections***

4. Claim **14** is objected to because of the following informalities:

Referring to claim **14**, the examiner notes that the claim is directed towards a method, while claim **8**, from which it depends, is directed towards a system. The examiner recommends that the phrase "[t]he method of claim **8**" be changed to "[t]he system of claim **8**" and interprets the claim in the Office Action below as though the recommended changes have been made.

Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims **24-27** are rejected under 35 U.S.C. 101, because the claimed invention is directed to non-statutory subject matter.

Referring to claims **24-27**, the claims are directed towards a machine-readable medium; however, the examiner notes that the specification is unclear as to what the medium is. As such, the machine-readable medium can be construed to be a signal. The examiner notes that a claim directed to a signal *per se* does not appear to be a process, machine, manufacture, or composition of matter. The examiner recommends that Applicant amend the claims to recite a “non-transitory” machine-readable medium. See **MPEP 2106.01** for guidance.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims **1, 3-5, 8, 10-12, 14-27** are rejected under 35 U.S.C. 102(e) as being anticipated by Dougherty et al.

Referring to claim 1, Dougherty et al. discloses a method, comprising:

- receiving one or more unmodified video data streams comprised of television content (local network affiliate receives video from national broadcaster)(col. 7, l. 20-35);
- creating one or more integrated video data streams by integrating interactive content into the one or more unmodified video data streams based on one or more rules targeting receiving devices in a particular geographic location (network affiliate's application server uses the EPG database to determine which interactive applications should be broadcast on a particular channel in a particular location at a particular time and retrieves the interactive applications corresponding to the particular channel, location, and time from the interactive content database. The application is then formatted and inserted into the broadcast signal)(col. 7, l. 48-67; col. 11, l. 10-32, 60-65; & col. 13, l. 25-33);
- transmitting the one or more integrated video data streams to one or more receiving devices having the particular geographic location for simultaneous display of the interactive content with the television content (col. 12, l. 29-43, 60-63 & col. 15, l. 41-45).

Referring to claim 3, Dougherty et al. discloses the method of claim 1, further comprising using data associated with the interactive content and data associated with the television content to link the interactive content with the television content (col. 11, l. 17-27 & col. 13, l. 25-33).

Referring to claim 4, Dougherty et al. discloses the method of claim 1, further comprising displaying the one or more integrated video data streams at the one or more receiving devices having the particular geographic location to allow a user to interact with the interactive content

(col. 15, l. 41-45 & col. 16, l. 13-17, 30-44).

Referring to claim **5**, Dougherty et al. discloses the method of claim 1, wherein integrating the interactive content into the one or more unmodified video data streams includes integrating the interactive content with the television content without modifying the interactive content and the television content (col. 11, l. 60-67 & col. 12, l. 1-4).

Referring to claim **8**, Dougherty et al. discloses a system for integrating content, comprising an integration unit configured to create one or more integrated video data streams by integrating interactive content into one or more unmodified video data streams comprised of television content (col. 7, l. 48-67 & col. 11, l. 10-32, 60-65) based on one or more rules targeting receiving devices in a particular geographic location (col. 13, l. 25-33), and further configured to transmit the one or more integrated video data streams to one or more receiving devices having the particular geographic location (col. 13, l. 25-33) for simultaneous display of the interactive content with the television content (col. 15, l. 41-45).

Referring to claim **10**, Dougherty et al. discloses the system of claim 8, further comprising:

- a storage unit configured to store data associated with the interactive content and data associated with the television content (col. 11, l. 17-27 & col. 13, l. 25-33); and
- a linking unit configured to link the interactive content with the television content based on the data stored in the storage unit (col. 11, l. 17-27 & col. 13, l. 25-33).

Referring to claim **11**, Dougherty et al. discloses the system of claim 8, further comprising:

- a receiving unit configured to receive the one or more integrated video data streams

- (col. 13, l. 54-67 & col. 14, l. 1-7); and
- a display unit configured to display the one or more integrated video data streams and to allow a user to interact with the interactive content (col. 14, l. 25-30 & col. 15, l. 23-45).

Referring to claim **12**, Dougherty et al. discloses the system of claim 8, wherein the integration unit is configured to integrate the interactive content with the television content without modifying the interactive content and the television content (col. 11, l. 60-67 & col. 12, l. 1-4).

Referring to claim **14**, Dougherty et al. discloses the system of claim 8, further comprising a tracking unit to track user interactions with the interactive content (col. 15, l. 27, 28, 41-54).

Referring to claim **15**, Dougherty et al. discloses a method for processing one or more video data streams, the method comprising:

- receiving one or more unmodified video data streams (local network affiliate receives video from national broadcaster)(col. 7, l. 20-35);
- downloading interactive content (col. 7, l. 48-59; col. 8, l. 57-62; & col. 11, l. 10-22);
- integrating, based on one or more rules targeting receiving devices in a particular geographic location, the interactive content with the one or more unmodified video data streams to create one or more integrated video data streams (network affiliate's application server uses the EPG database to determine which interactive applications should be broadcast on a particular channel in a particular location at a particular time and retrieves the interactive applications corresponding to the particular channel,

location, and time from the interactive content database. The application is then formatted and inserted into the broadcast signal)(col. 7, l. 48-67; col. 11, l. 10-32, 60-65; & col. 13, l. 25-33); and

- transmitting the one or more integrated video data streams to one or more receiving devices having the particular geographic location for simultaneous display of the interactive content with the one or more unmodified video data streams (col. 12, l. 29-43, 60-63 & col. 15, l. 41-45).

Referring to claim 16, Dougherty et al. discloses the method of claim 15, further comprising:

- displaying the one or more integrated video data streams at the one or more receiving devices having the particular geographic location (col. 14, l. 25-30 & col. 15, l. 23-45); and
- launching interactive services via the one or more integrated video data streams (col. 14, l. 25-30 & col. 15, l. 23-45).

Referring to claim 17, Dougherty et al. discloses the method of claim 15, wherein the one or more receiving devices having the particular geographic location include a set-top box (col. 13, l. 52-57).

Referring to claim 18, Dougherty et al. discloses the method of claim 15, wherein the one or more unmodified video data streams includes television commercial content (col. 7, l. 28 & col. 9, l. 55-62).

Referring to claim 19, Dougherty et al. discloses the method of claim 15, further comprising defining the particular geographic location to target receiving devices associated with

a specific market or group (col. 13, l. 25-33 & col. 16, l. 30-44).

Referring to claim **20**, Dougherty et al. discloses a system for processing one or more video data streams comprising:

- a receiving unit configured to receive one or more unmodified video data streams (local network affiliate receives video from national broadcaster)(col. 7, l. 20-35);
- a downloading unit configured to download interactive content (col. 7, l. 48-59; col. 8, l. 57-62; & col. 11, l. 10-22);
- an integration unit configured to integrate, based on one or more rules targeting receiving devices in a particular geographic location, the interactive content with the one or more unmodified video data streams to create one or more integrated video data streams (network affiliate's application server uses the EPG database to determine which interactive applications should be broadcast on a particular channel in a particular location at a particular time and retrieves the interactive applications corresponding to the particular channel, location, and time from the interactive content database. The application is then formatted and inserted into the broadcast signal)(col. 7, l. 48-67; col. 11, l. 10-32, 60-65; & col. 13, l. 25-33); and
- a transmitting unit configured to transmit the integrated video data streams to one or more receiving devices having the particular geographic location for simultaneous display of the interactive content with the one or more unmodified video data streams (col. 12, l. 29-43, 60-63 & col. 15, l. 41-45).

Referring to claim **21**, Dougherty et al. discloses the system of claim 20, wherein the one or more receiving devices having the particular geographic location include a set-top box (col.

13, l. 52-57).

Referring to claim **22**, Dougherty et al. discloses the system of claim 20, wherein the one or more unmodified video data streams include television commercial content (col. 7, l. 28 & col. 9, l. 55-62).

Referring to claim **23**, Dougherty et al. discloses the system of claim 20, further comprising a targeting unit configured to define the particular geographic location to target receiving devices associated with a specific market or group (col. 13, l. 25-33 & col. 16, l. 30-44).

Referring to claim **24**, Dougherty et al. discloses a machine-readable medium providing instructions, which if executed by a processor, causes the processor to perform an operation, comprising:

- creating one or more integrated video data streams by integrating, based on one or more rules targeting receiving devices in a particular geographic location, interactive content with one or more unmodified video data streams comprised of television content (network affiliate's application server uses the EPG database to determine which interactive applications should be broadcast on a particular channel in a particular location at a particular time and retrieves the interactive applications corresponding to the particular channel, location, and time from the interactive content database. The application is then formatted and inserted into the broadcast signal)(col. 7, l. 48-67; col. 11, l. 10-32, 60-65; & col. 13, l. 25-33); and
- transmitting the one or more integrated video data streams to one or more receiving devices having the particular geographic location for simultaneous display of the

interactive content with the television content (col. 12, l. 29-43, 60-63 & col. 15, l. 41-45).

Referring to claim **25**, Dougherty et al. discloses the machine-readable medium of claim 24, further providing instructions, which if executed by the processor, cause the processor to perform an operation comprising using data associated with the interactive content and data associated with the television content to link the interactive content with the television content (col. 11, l. 17-27 & col. 13, l. 25-33).

Referring to claim **26**, Dougherty et al. discloses the machine-readable medium of claim 24, further comprising instructions, which if executed by the processor, cause the processor to perform an operation comprising displaying the one or more integrated video data streams at the one or more receiving devices having the particular geographic location to allow a user to interact with the interactive content (col. 14, l. 25-30 & col. 15, l. 23-45).

Referring to claim **27**, Dougherty et al. discloses a machine-readable medium providing instructions, which if executed by a processor, causes the processor to perform an operation comprising:

- receiving one or more unmodified video data streams (local network affiliate receives video from national broadcaster)(col. 7, l. 20-35);
- downloading interactive content (col. 7, l. 48-59; col. 8, l. 57-62; & col. 11, l. 10-22);
- integrating, based on one or more rules targeting receiving devices in a particular geographic location, the interactive content with the one or more unmodified video data streams to create one or more integrated video data streams (network affiliate's application server uses the EPG database to determine which interactive applications

- should be broadcast on a particular channel in a particular location at a particular time and retrieves the interactive applications corresponding to the particular channel, location, and time from the interactive content database. The application is then formatted and inserted into the broadcast signal)(col. 7, l. 48-67; col. 11, l. 10-32, 60-65; & col. 13, l. 25-33); and
- transmitting the one or more integrated video data streams to one or more receiving devices having the particular geographic location for simultaneous display of the interactive content with the one or more unmodified video data streams (col. 12, l. 29-43, 60-63 & col. 15, l. 41-45).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims **2, 6, 9, 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Dougherty et al. in view of Blackketter et al.

Referring to claims **2, 6, 9, and 13**, Dougherty et al. discloses the method/system of claims 1 and 8, wherein the interactive content includes Internet content (and the television content includes television commercial content (col. 7, l. 27-28 & col. 8, l. 57-62). Dougherty et al. does not specifically disclose that the interactive content being combined with the television commercial content is Internet advertising content. Dougherty et al. further does not specifically

disclose that the interactive content includes an advertising banner. Blackketter et al. discloses embedding an interactive advertisement summary into a television commercial for broadcast (col. 7, l. 60-67). The advertisement summary contains hyperlinks to additional information of interest (col. 6, l. 53-67 & col. 7, l. 1). For example, a broadcast television commercial may be sponsored by a cruise line and an interactive advertisement related to the commercial may be displayed (col. 4, l. 41-46 & Fig. 4). The examiner interprets the custom ad of Figure 4 to be an advertising banner. A user might select hyperlink 490 to establish an Internet connection to a server to obtain additional information about the advertised cruise (col. 7, l. 2-4). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the Internet content of Dougherty et al. to include Internet advertising content, such as that taught by Blackketter et al. in order to provide a better user interactive advertising experience (Blackketter et al. col. 3, l. 4-6).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL VAN HANDEL whose telephone number is (571)272-5968. The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Van Handel/  
Primary Examiner, Art Unit 2424

11/06/2010